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ART UNIT	PAPER NUMBER
2624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/510,167	HILPL ET AL.
	Examiner	Art Unit
	Thierry L Pham	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Claim Objections

1.   Claims 4, 9, 16, 21, 26, 33, 38, 43, and 50 objected to because of the following

informalities: "Varifying" should read as "Verifying". Appropriate action required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

2.   Claims 1, 18, 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the enablement requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. The specification does not

provide an adequate written description of the limitations as recited in claims 1, 18, and 35,

wherein "the conflict attributes including at least one of a policy"; therefore, it does not enable

one skilled in the art to make, use and/or practice the claimed invention.

3.   Claims 12-13, 29-30, 46-47 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the enablement requirement.   The claims (s) contains subject matter which was

not described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.   The

specification does not provide an adequate written description of the limitations as recited in

claims 12-13, 29-30, and 46-47, wherein checking for "itinerary" to process a sheet according to

the at least one received job attribute; therefore, it does not enable one skilled in the art to make,

use and/or practice the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-2, 5-6, 10, 12-13, 18-19, 22-23, 27, 29-30, 35-36, 39-40, 44, 46-47 are rejected

under 35 U.S.C. 102(b) as being anticipated by Hower et al (U.S. Pat. 5467434).

5.   Regarding claim 18, Hower discloses a printer comprising a processor and a plurality of

modules to control the processor, wherein the modules include:

(1) a module to initiate (initiate by using a keyboard, col. 1, line 24 to program a print

job, col. 4, lines 4-5) a save conflict mode (finishing option conflict rules, Fig. 13, col. 7,

lines 55-67); and

(2) one of a module to store (col. 9, line 46) print job attribute (quantity, finishing, col. 4,

lines 4-8) in a conflict list (col. 6, lines 65-67 and col. 7, lines 1-3) while in the save

conflict mode and storing conflict attributes based on the print job attributes while in the

save conflict mode, the conflict attributes including at least one of a policy, a capability

and a constraint (finishing capability, col. 7, lines 55-67).

6.   Regarding claim 19, Hower further discloses a printer, wherein the module to store print job attributes includes logic at least one of an enlargement/reduction (col.4, lines 5-8) parameter, an orientation, a simplex/duplex parameter, a sort parameter, a binding parameter, and a fed medium select parameter.

7.   Regarding claims 1-2: Claims 1-2 are the method claims corresponding to the module claims 18-19 (respectively) above as being anticipated by Hower et al. The above cited-passages also teach claims 1-2.

8.   Regarding claims 35-36: Claims 35-36 are the computer readable media claims corresponding to the module claims 18-19 (respectively) above as being anticipated by Hower et al. The above cited-passages also teach claims 35-36. Computer readable media is disclosed by Hower (Document Directory, Fig. 2).

9.   Regarding claim 22, Hower further discloses a printer, further comprising:

        (1) a module to receive from a user at least one job attribute (finishing options, col. 7, lines 55-67) that causes a conflict; and

        (2) a module to check the at least one received job attribute against the stored print job attributes (Fig. 8, col. 4, lines 52-55).

10.   Regarding claim 23, Hower further discloses a printer, further comprising:

(1) a module to determine (determine if the media type selected by the user is in the first

printer profile combinations, col. 6, lines 20-47) whether a conflict condition exists (set

of rules which describe the finishing, formatting, and output capabilities of the associated

printer, col. 5, lines 13-20); and

(2) a module to display (displaying via an User Interface and monitor, Fig. 1, Abstract

and col. 1, line 23) a conflict message (fault message, col. 9, line 64) when the conflict

condition is determined to exist.

11.   Regarding claims 5-6: Claims 5-6 are the method claims corresponding to the module

claims 22-23 (respectively) above as being anticipated by Hower et al. The above cited-passages

also teach claims 5-6.

12.   Regarding claims 39-40: Claims 39-40 are the computer readable media claims

corresponding to the module claims 22-23 (respectively) above as being anticipated by Hower et

al. The above cited-passages also teach claims 39-40. Computer readable media is disclosed by

Hower (Document Directory, Fig. 2).

13.   Regarding claim 27, Hower further discloses a printer, wherein the module to store

conflict attributes includes logic to formulate (Fig. 9, col. 3, lines 8-9) the conflict attributes

based on at least one of an enlargement/reduction parameter, an orientation, a simplex/duplex

parameter, a sort parameter, a binding parameter, and a fed medium select parameter (Fig. 4).

14.   Regarding claim 10: Claim 10 is a method claim corresponding to a module claim 27

above as being anticipated by Hower et al. The above cited-passages also teach claim 10.

15.   Regarding claim 44: Claim 44 is a computer readable media claim corresponding to the

module claim 27 above as being anticipated by Hower et al. The above cited-passages also teach

claim 44. Computer readable media is disclosed by Hower (Document Directory, Fig. 2).

16.   Regarding claim 29, Hower further discloses a method to program a printer further

comprising steps of:

> (1) receiving from a user at least one job attribute that causes a conflict (finishing options,
>
> col. 7, lines 55-67); and
>
> (2) checking for an itinerary (media property, finishing option, col. 10, lines 7-11) to
>
> process a sheet according to the at least one received job attribute (media type, col. 10,
>
> lines 7-11).

17.   Regarding claim 30, Hower further discloses a printer further comprising:

> (1) a module to determine whether an itinerary is unavailable due to a conflict condition
>
> (the present invention relates generally to printing systems, and more particularly to a
>
> technique for determining whether a combination of print job selections is available at a
>
> given printer having a predetermined set of printer properties, col. 1, lines 7-10); and
>
> (2) a module to display a conflict message (a fault message is displayed at said
>
> programming means when the combination of print job selections does not correspond

with the subset of the set of the printer properties available at the one of the plurality of

printers associated with the selected one of the printer profiles, col. 9, lines 64-67 and col.

10, lines 1-3) when the itinerary is unavailable due to a conflict condition.

18.   Regarding claims 12-13: Claims 12-13 are the method claims corresponding to the

module claims 29-30 above as being anticipated by Hower et al. The above cited-passages also

teach claims 12-13.

19.   Regarding claims 46-47: Claims 46-47 are the computer readable media claims

corresponding to the module claims 29-30 above as being anticipated by Hower et al. The above

cited-passages also teach claims 46-47. Computer readable media is disclosed by Hower

(Document Directory, Fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20.   Claims 3-4, 8-9, 15-16, 20-21, 25-26, 37-38, 42-43 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Hower as applied to claim 1 above, and further in view of Yokoyama

(U.S. Pat. 6166826).

21.   Regarding claim 20, Hower discloses a printer comprising a processor and a plurality of modules to control the processor, wherein the module to initiate a save conflict mode includes:

(1) logic to receive from a user at least one print job attribute (finishing options, col. 7, lines 55-67) that causes a conflict; and

However, Hower's module of a printer does not include a module to recognize a user initiated save conflict mode command.

Yokoyama, in the same field of endeavor for setting printer's attribute (Fig. 3, col. 9, lines 7-15), teaches a module to recognize a user initiated save (user wants to store print data, col. 9, lines 64-67 and col. 10, lines 1-5) conflict mode. Since Yokoyama's invention teaches a step of storing print data along with a password to prevent unauthorized access to confidential materials; therefore, his invention also capable of verifying a user who wants to edit and save the printing settings (col. 12, lines 22-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hower's method of programming a printer by the teachings of Yokoyama because of the following reasons: (1) erroneous printing can be prevented for improving the printing efficiency (Yokoyama, col. 12, lines 59-62); (2) response time of the printer can be shortened and communication path traffic can be decreased (Yokoyama, col. 12, lines 65-67); (3) confidential materials can be protected against unauthorized users (Yokoyama, col. 14, lines 21-29).   Therefore, it would have been obvious to combine Yokoyama with Hower to obtain the invention as specified in claim 20.

22.   Regarding claim 21, Yokoyama further discloses a module to program a printer, wherein

the module of initiating a save conflict mode further includes verifying that the user is an

authorized user (password, col. 12, lines 27-32).

23.   Regarding claims 3-4: Claims 3-4 are the method claims corresponding to the module

claims 20-21 above as per teachings by Hower and Yokoyama. The above cited-passages also

teach claims 3-4.

24.   Regarding claims 37-38: Claims 37-38 are the computer readable media claims

corresponding to the module claims 20-21 above as per teachings by Hower and Yokoyama.

The above cited-passages also teach claims 37-38. Computer readable media is disclosed by

Hower (Document Directory, Fig. 2).

25.   Regarding claims 25-26, the limitations recited in claims 25-26 are included in claims 20-

21 (respectively); therefore, claims 25-26 are rejected for the same basis/rationale as described in

claims 20-21 above.

26.   Regarding claims 8-9: Claims 8-9 are the method claims corresponding to the module

claims 25-26 above as per teachings by Hower and Yokoyama. The above cited-passages also

teach claims 8-9.

27.   Regarding claims 42-43: Claims 42-43 are the computer readable media claims corresponding to the module claims 25-26 above as per teachings by Hower and Yokoyama. The above cited-passages also teach claims 42-43. Computer readable media is disclosed by Hower (Document Directory, Fig. 2).

28.   Regarding claims 12-13: Claims 12-13 are the method claims corresponding to the module claims 29-30 above as per teachings by Hower and Yokoyama. The above cited-passages also teach claims 12-13.

29.   Regarding claims 46-47: Claims 46-47 are the computer readable media claims corresponding to the module claims 29-30 above as per teachings by Hower and Yokoyama. The above cited-passages also teach claims 46-47. Computer readable media is disclosed by Hower (Document Directory, Fig. 2).

30.   Regarding claims 32-33, the limitations recited in claims 32-33 are included in claims 20-21 (respectively); therefore, claims 32-33 are rejected for the same basis/rationale as described in claims 20-21 above.

31.   Regarding claims 15-16: Claims 15-16 are the method claims corresponding to the module claims 32-33 above as per teachings by Hower and Yokoyama. The above cited-passages also teach claims 15-16.

32.   Regarding claims 49-50: Claims 49-50 are the computer readable media claims

corresponding to the module claims 32-33 above as per teachings by Hower and Yokoyama.

The above cited-passages also teach claims 49-50. Computer readable media is disclosed by

Hower (Document Directory, Fig. 2).

33.   Claims 7, 11, 14, 17, 24, 28, 31, 34, 41, 45, 48, 51 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Hower et al (U.S. Pat. 5467434) as applied to claim 1 above, and to

Barrett (U.S. Pat. 5260805), and further in view of Neuhard et al (U.S. Pat. 6335795).

34.   Regarding claims 24 & 31, Hower discloses a printer, but does not include the module

comprising of: (1) a module to initiate a delete conflict mode; and (2) a module to delete the

stored print job attributes from the conflict list.

        Barrett, in the same field of endeavor for resolving print attributes conflict, discloses a

method to program a printer comprising the steps of: (1) a module to initiate a delete conflict

mode (a conflict is identified by means of message displayed on touch-screen informing the

operator that a conflict exists together with a suggested procedure for removing the conflict, col.

7, lines 34-47).

        The combinations of Hower and Barrett do not teach a printer include a module for

deleting the stored print job attributes from the conflict list.

        Neuhard, in the same field of endeavor for resolving print attributes conflict, teaches a

module to delete the stored print job attributes (col.9, lines 60-65) from the conflict list.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hower's method for programming the printer by the teachings of Neuhard and Barrett because of a following reason: (1) to minimize time spent query for print options available in the network printing system, Neuhard, col. 3, lines 6-8; thereby, reduce operating costs. Therefore, it would have been obvious to combine Neuhard and Barrett with Hower to obtain the invention as specified in claims 24 and 31.

35.   Regarding claims 7 & 14: Claims 7 & 14 are the method claims corresponding to the module claims 24 & 31 (respectively) above as per teachings by Hower, Barrett, and Neuhard. The above cited-passages also teach claims 7 & 14.

36.   Regarding claims 41 & 48: Claims 41 & 48 are the computer readable media claims corresponding to the module claims 24 & 31 (respectively) above as per teachings by Hower Barrett, and Neuhard. The above cited-passages also teach claims 41 & 48. Computer readable media is disclosed by Hower (Document Directory, Fig. 2).

37.   Regarding claims 28 & 34, Neuhard further discloses a module to program a printer, wherein the module include reinitializing scheduler (the spooler/scheduler 20 of Fig. 1 receives the print jobs from the client computers and generates printer files that are transmitted to the printer, col. 4, lines 29-37) after storing/deleting the conflict attributes.

38.   Regarding claims 11 & 17: Claims 11 & 17 are the method claims corresponding to the

module claims 28 & 34 above as per teachings by Hower, Barrett, and Neuhard. The above

cited-passages also teach claims 11 & 17.

39.   Regarding claims 45 & 51: Claims 45 & 51 are the computer readable media claims

corresponding to the module claims 28 & 34 above as per teachings by Hower, Barret, and

Neuhard. The above cited-passages also teach claims 45 & 51. Computer readable media is

disclosed by Hower (Document Directory, Fig. 2).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. The following patents/publications are relevant to applicant's disclosure invention.

U.S. 5049929 to Anderson et al.

U.S. 5063535 to Jacobs et al.

U.S. 5129639 to Dehority.

U.S. 5600762 to Salgado et al.

EPO 0915414 A2 to Hiroki et al.

Abstracted Derwent Account. 1993-203469 (printer's setting w/ password).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The

examiner can normally be reached on M-F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703)305-3900.

Thierry L. Pham

Oct. 7, 2003

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